

REMARKS

I. Introduction

With the cancellation herein without prejudice of claims 12 and 13 and the addition of new claims 18 to 20, claims 9 to 11 and 14 to 20 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Foreign Priority Claim

As an initial matter, it is noted that the Office Action Summary does not include an acknowledgment of the claim for foreign priority or an indication as to whether the certified copy of the priority document has been received. In this regard, the present application claims priority to German Patent Application No. 103 16 933.4, filed on April 12, 2003. A claim of priority to German Patent Application No. 103 16 933.4 was made, inter alia, in the "Declaration" submitted on August 7, 2006. At least the "Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495" dated November 29, 2006 indicates that the priority document has been received by the Office.

III. Claim Numbering

Applicant notes with appreciation the renumbering the second instance of claim 11 and claims 12 to 16 as claims 12 to 17. The Examiner will note that claims 14 and 16 have been amended herein without prejudice to correct their dependencies.

IV. Information Disclosure Statement

Regarding the contention that the Information Disclosure Statement submitted on October 12, 2005 does not comply with the requirements of 37 C.F.R. § 1.98(a)(3), it is first noted that EP 0 343 593 and EP 0 329 436 were each published in English. As such, a concise explanation of relevance of these two documents is not required.

Regarding SU 599130 and RU 2 143 678, an English-language abstract of each of these two documents was submitted as indicated in the PTO-1449 paper submitted on October 12, 2005, and each of these two documents

were cited in the International Search Report in the underlying PCT application as also indicated in the PTO-1449 paper submitted on October 12, 2005. The International Search Report categorized each of these two documents as “A” documents, and an English-language copy of the International Search Report was submitted on October 12, 2005. As indicated in M.P.E.P. § 609.04(a)(III), the requirement for a concise explanation of relevance for non-English language information is satisfied, inter alia, by submission of either: (a) an English-language abstract; or (b) an English-language version of a search report which indicates the degree of relevance (e.g., an explanation of which portion of a reference is particularly relevant, to which claim it applies, or merely an “X”, “Y”, or “A” indication on a search report) found by a foreign patent office in a counterpart application. Since both an English-language abstract of SU 599130 and RU 2 143 678 and an English-language version of the International Search Report that lists SU 599130 and RU 2 143 678 were submitted, the requirements of 37 C.F.R. § 1.98(a)(3) are fully satisfied.

Despite the alleged deficiency of the Information Disclosure Statement, EP 0 343 593, EP 0 329 436, SU 599130 and RU 2 143 678 should have been considered. In this regard, each of EP 0 343 593, EP 0 329 436, SU 599130 and RU 2 143 678 was cited in the International Search Report, an English-language version of which was submitted on October 12, 2005. Furthermore, at least the “Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495” dated November 29, 2006 indicates that the Office received the International Search Report and copies of the references cited in the International Search Report. As stated in M.P.E.P. § 609.03, “[t]he examiner will consider the documents cited in the international search report in a PCT national stage application when the Form PCT/DO/EO/903 indicates that both the international search report and the copies of the documents are present in the national stage file” (emphasis added). See also M.P.E.P. § 1893.03(f) (“The examiner will consider the documents cited in the international search report, **without any further action by applicant under 37 CFR 1.97 and 1.98**, when both the international search report and copies of the documents are indicated to be present in the national stage file” (emphasis added)). Since both the International Search Report and the documents cited therein were indicated by the Office to be present in this national stage application file,

consideration of EP 0 343 593, EP 0 329 436, SU 599130 and RU 2 143 678, even despite the alleged deficiency of the Information Disclosure Statement, is required.

In view of the foregoing, consideration of EP 0 343 593, EP 0 329 436, SU 599130 and RU 2 143 678 and an indication of consideration of EP 0 343 593, EP 0 329 436, SU 599130 and RU 2 143 678 are respectfully requested in the next Office communication.

V. Rejection of Claims 9, 10, 12, 13 and 15 to 17 Under 35 U.S.C. § 102(b)

Claims 9, 10, 12, 13 and 15 to 17 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,942,364 ("Nishijima et al."). It is respectfully submitted that Nishijima et al. do not anticipate the present claims for at least the following reasons.

As an initial matter, claims 12 and 13 have been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claims 12 and 13.

Claim 9 relates to a sensor system. As amended herein without prejudice, claim 9 recites that the sensor system includes: a thin-film sensor including a surface having at least two contact areas; and a printed circuit board including a surface having at least two contact pads. The surface of the thin-film sensor faces away from the surface of the printed circuit board. A conductive adhesive, which is adapted to transmit sensor currents from the thin-film sensor to the printed circuit board, adheres to the contact areas of the thin-film sensor and the contact pads on the surface of the printed circuit board. Claim 9 has been amended herein without prejudice to recite that each contact area is joined by the conductive adhesive to a corresponding contact pad of the printed circuit board. Support for this amendment may be found, for example, in claim 12. Claim 9 has been further amended herein without prejudice to recite that the sensor system further includes a mounting adhesive, which is applied on the surface of the printed circuit board in between the contact pads and which is arranged at least in one partial area between the thin-film sensor and the surface of the printed circuit board. Support for this amendment may be found, for example, on page 6, lines 23 to 28 and page 7, lines 15 to 21 of the Specification, and in claim 13.

The Office Action contends that conductive contacting portions 3 described by Nishijima et al. constitute both a conductive adhesive and a mounting adhesive. However, this contention is untenable, since, according to claim 9, a mounting adhesive is applied to a surface of a printed circuit board **in between** contact pads, which are located on the surface of the printed circuit board, to which a conductive adhesive adheres. While Nishijima et al. mention an insulating layer 8, insulating layer 8 cannot be reasonably considered to constitute either a conductive adhesive or a mounting adhesive within the context of claim 9. In this regard, to the extent that aluminium printed circuit board 13 is considered to constitute a printed circuit board within the context of claim 9, Nishijima et al. do not disclose “a printed circuit board including a surface having at least two contact pads.” This is because the insulating layer 8, as illustrated, e.g., in Fig. 11(b) is disposed between the aluminium printed circuit board 13 and the electrode circuit 2. Furthermore, to the extent that the insulating layer 8, in combination with the aluminium printed circuit board 13, might be considered to constitute a printed circuit board in the context of claim 9, a mounting adhesive applied to a surface of a printed circuit board is absent.

It is “well settled that the burden of establishing a prima facie case of anticipation resides with the [United States] Patent and Trademark Office.” Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1788 to 1789 (Bd. Pat. App. & Inter. 1986). To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

As set forth above, it is plainly apparent that Nishijima et al. fail to disclose, or even suggest, all of the features included in amended claim 9. As such, it is respectfully submitted that Nishijima et al. do not anticipate amended claim 9.

As for claim 10, which depends from claim 9 and therefore includes all of the features included in claim 9, it is respectfully submitted that Nishijima et al. do not anticipate dependent claim 10 for at least the reasons more fully set forth above.

Regarding independent claim 15 and dependent claim 16, which depends from claim 15, since claim 15 includes features analogous to features included in claim 9, it is respectfully submitted that Nishijima et al. do not anticipate claims 15 and 16 for at least the reasons more fully set forth above.

Regarding independent claim 17, since claim 17 includes features analogous to features included in claim 9, it is respectfully submitted that Nishijima et al. do not anticipate claim 17 for at least the reasons more fully set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VI. Rejection of Claim 11 Under 35 U.S.C. § 103(a)

Claim 11 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Nishijima et al. and U.S. Patent No. 6,867,602 ("Davis et al."). It is respectfully submitted that the combination of Nishijima et al. and Davis et al. does not render unpatentable claim 11 for at least the following reasons.

Among the requirements for rendering a claim unpatentable under 35 U.S.C. § 103(a) is that all of the features of the claim must be disclosed or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 11 depends from claim 9 and therefore includes all of the features included in claim 9. As more fully set forth above, Nishijima et al. do not disclose, or even suggest, all of the features included in claim 9. Davis et al. are not relied upon for disclosing or suggesting the features of claim 9 not disclosed or suggested by Nishijima et al. Indeed, it is respectfully submitted that Davis et al. do not disclose, or even suggest, the features included in claim 9 not disclosed or suggested by Nishijima et al. As such, it is respectfully submitted that the combination of Nishijima et al. and Davis et al. do not render unpatentable claim 11, which depends from claim 9.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VII. Rejection of Claim 14 Under 35 U.S.C. § 103(a)

Claim 14 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Nishijima et al. and U.S. Patent No. 6,967,439. It is respectfully

submitted that the combination of Nishijima et al. and U.S. Patent No. 6,967,439 does not render unpatentable claim 14 for at least the following reasons.

As an initial matter, claim 14 depends from claim 9 and therefore includes all of the features included in claim 9. Thus, it is respectfully submitted that claim 14 is patentable at least because of its dependency from claim 9.

Furthermore, U.S. Patent No. 6,967,439 issued on **November 22, 2005** from U.S. Patent Application Serial No. 10/785,825, which was filed on **February 24, 2004**. As indicated above, the present application claims priority to German Patent Application No. 103 16 933.4, which was filed on **April 12, 2003**, i.e., plainly **before** the **February 24, 2004** filing date of U.S. Patent No. 6,967,439. A claim of priority to German Patent Application No. 103 16 933.4 was made, inter alia, in the "Declaration" submitted on August 7, 2006, and the "Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495" dated November 29, 2006 indicates that the priority document has been received by the Office. A certified translation of German Patent Application No. 103 16 933.4 will be submitted under separate cover. As such, it is respectfully submitted that U.S. Patent No. 6,967,439 does not constitute prior art against the present application.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

VIII. New Claims 18 to 20

New claims 18 to 20 have been added herein. It is respectfully submitted that claims 18 to 20 add no new matter and are fully supported by the present application, including the Specification.

Since claim 18 depends from claim 9, it is respectfully submitted that claim 18 is patentable over the references relied upon for at least the reasons set forth above in support of the patentability of claim 9.

Since claim 19 depends from claim 15, it is respectfully submitted that claim 19 is patentable over the references relied upon for at least the reasons set forth above in support of the patentability of claim 15.

Since claim 20 depends from claim 17, it is respectfully submitted that claim 20 is patentable over the references relied upon for at least the reasons set forth above in support of the patentability of claim 17.

IX. Fees

No fees are believed to be required in connection with this paper. However, if any fees are required in connection with this paper or this application, the Director is authorized to charge any and all such fees to the deposit account of KENYON & KENYON LLP, Deposit Account No. **11-0600**.

X. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,



Date: October 16, 2007

By: / _____ /

Clifford A. Ulrich
Reg. No. 42,194

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646